

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q76502

Beatrice MARTIN, et al.

Appln. No.: 10/629,597

Group Art Unit: 2444

Confirmation No.: 6211

Examiner: Mohamed IBRAHIM

Filed: July 30, 2003

For: A DEVICE FOR TAKING CONTROL OF RESOURCES IN A COMMUNICATION
NETWORK IN ORDER TO INSERT TRAFFIC

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated January 8, 2009. Entry of this
Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-21 are all the claims pending in the application and the subject of this appeal.

Claims 1-8, 10-12, 14, and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Torikka et al. (U.S. Patent No. 6,937,577, hereafter "Torikka"). Claims 9, 13, 15, and 17-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Torikka in view of Karabinis (U.S. Patent No. 6,856,787).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

I. Rejection of claims 1-8, 10-12, 14 and 16 under 35 U.S.C. § 102(e) as being anticipated by Torikka.

II. Rejection of claims 9, 13, 15, and 17-21 under 35 U.S.C. § 103(a) as being unpatentable over Torikka in view of Karabinis.

No other grounds of rejection or objection are currently pending.

ARGUMENT

In addition to the arguments set forth in the Appeal Brief filed on September 24, 2008, Appellant responds to certain points made in the Examiner's Answer as follows:

As noted in the Appeal Brief, Appellant submitted that in the Office Actions of record, the Examiner has failed to clearly establish or specify how the claimed "data management device" allegedly reads on the cited reference – Torikka.

In the "Response to Arguments" section of the final Office Action of November 27, 2007,¹ the Examiner asserted that "[t]he terminology used to refer to the data management device of the prior art may be different than that which is used in the instant application". However, the Examiner failed to indicate what "terminology" in the prior art is used to refer to the data management device. Nowhere does any portion of Torikka teach or suggest a data management device which takes control, on command, of at least a portion of the resources of a base station instead of a terrestrial node, to enable transfer of data between a traffic source and the base station, as required by independent claim 1.

The Examiner now asserts:

Appellant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims... This is important as Appellant argues, first paragraph on page 12 of brief, that the 'data management device' is a separate device from the RNC.²

¹ Page 3 of the Final Office Action.

² Page 11 of the Examiner's Answer.

Appellant submits that the claims are to be interpreted or construed in light of the specification. Further, the standard for claim interpretation is the broadest *reasonable* interpretation consistent with the specification. See MPEP 2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Applicant respectfully submits that the Examiner's interpretation of the claim language is unreasonable and improper.

Independent claim 1 requires a data management device (for example, D in FIG 2) comprising control means configured to be coupled to a traffic source (for example TS, in FIG 2) and to an interface (for example, lub), and configured to take local control, on command, of at least a portion of the resources of a base station **instead** of the terrestrial node to enable transfer of data between the traffic source and the base station.

Appellant respectfully submits that one of ordinary skill in the art would readily recognize that if the data management device takes control of the resources of the base station instead of the terrestrial node, then the data management device and the terrestrial node are different entities. This is also clearly depicted at least in FIG. 2, where the device (D) and the terrestrial node (RNC) are depicted as separate modules. Additionally, the original specification discloses at least on page 12, lines 13-16 that the device (D) can be substituted for the RNC (terrestrial node). Accordingly, Appellant respectfully submits that the claims and the specification clearly specify that the data management device and the terrestrial node are separate units.

As Appellant noted in the Appeal Brief, there is no teaching or suggestion in Torikka of a data management device which includes control means configured to be coupled to a traffic source, and which takes local control, on command, of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between the traffic source and the base station, as required by independent claim 1.

The Examiner now appears to change the previous rejections and the previously stated position and asserts that the above-quoted feature “is found to be a recitation of the intended use of the claimed invention. In order for it to be given patentable weight this feature must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art”.³

Appellant respectfully disagrees with the Examiner. The claimed invention discloses a data management device (D) coupled to a traffic source and to an interface and configured to take local control, on command of at least a portion of the resources of a base station instead of the terrestrial node. Torikka does not teach (nor does the Examiner specifically provide support for) a data management device coupled to a traffic source, and operative to take local control of the resources of a base station. Torikka discloses a Radio Network Controller connected to a Base station and a switching device (see FIG. 1), while FIG 2 of the present invention illustrates a data management device connected to a traffic source, a radio network controller and a base station (Node B). Accordingly, the structural differences between the claimed invention and

³ Pages 11-12 of the Examiner’s Answer.

Torikka are quite clear, thus further undermining the Examiner's basis for the rejection. These elements of the claim are not "intended use" as asserted by the Examiner, but are essential elements of the claim.

Additionally, the Examiner now appears to assert that the above-quoted element "the device comprising control means configured to be coupled to a traffic source and to said interface and configured to take local control, on command, of at least a portion of said resources of said base station, instead of said terrestrial node, to enable transfer of data between said traffic source and said base station", as recited in claim 1 should not be given patentable weight. Appellant finds the Examiner's position confusing, since the Examiner has considered the recited elements in every Office Action of record, thus again undermining the Examiner's new position.

The Examiner further asserts that "if the prior art structure is capable of performing the intended use, then it meets the claim."⁴ However, as discussed above, it is quite clear that Torikka does not perform the functions of the claimed invention, since the cited reference does not teach or suggest a data management device which takes control of at least a portion of the resources of a base station, instead of a terrestrial node, to enable transfer of data between a traffic source and the base station.

For at least these reasons, Appellant respectfully submits that the Examiner § 102 rejection of claims 1-8, 10-12, 14, and 16 as well and the § 103 rejection of claims 9, 13, 15, and 17-21 is improper, and respectfully submits that the rejection of claims 1-21 should be reversed.

⁴ Page 12 of the Examiner's Answer.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

/Mark E. Wallerson/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: March 9, 2009

Mark E. Wallerson
Registration No. 59,043